

REMARKS

Claims 1-11 were presented for examination, and Claims 1-14 are now present in the case.

The undersigned's attention was recently directed to the fact that Compound X in the Ryabukhin et al. reference which is listed in Sheet 2 of the PTO-1449 form which accompanied the Preliminary Amendment and Information Disclosure Statement filed February 7, 2001, is embraced by "original" Claim 5. Accordingly, the significance "unsubstituted aryl" has been deleted from the definition of the "R₃" substituent in said claim, and the proviso has been amended consistent with said deletion. In this connection, it should be noted that the Ryabukhin et al. reference is silent with regard to any teaching that the compounds disclosed therein are useful for treating diseases, let alone the diseases disclosed in the instant specification. In addition, the Ryabukhin et al. reference is silent with regard to any teaching that the compounds disclosed therein are suitable metal chelators. In any event, the above-mentioned amendment to Claim 5 is supported by the CCPA decision rendered in *In re Driscoll*, 195 USPQ 434.

"New" Claim 12, which is directed to the specific compound of Example 41, has been added.

New "pharmaceutical composition species Claim 13" and "method-of-use species Claim 14", both of which are directed to the specific compound of Example 5 (covered by "original" Claim 9), have been added.

In any event, attached is an Appendix which represents a marked-up version of the changes made to Claim 5 by the foregoing amendment.

Restriction has been required under 35 U.S.C. §121 among the following three groups:

- 1) Group I - Claims 1-4 directed to various diseases which cause an excess of metal or are caused by it, and to pharmaceutical preparations.
- 2) Group II - Claims 5-10 directed to compounds, per se, and to pharmaceutical compositions containing them.
- 3) Group III - Claim 11 directed to a method of treating iron overload utilizing a compound of Group II.

In response thereto, Applicants respectfully elect the Group II invention with traverse. Applicants respectfully submit that the requirement for restriction among the three groups is improper and should be withdrawn because the subject matter of the three groups is not patentably distinct. As to Groups I and II, the scope of formula II is fully embraced by the scope of formula I. The only difference is that, in contrast to formula II, the scope of formula I also embraces known compounds having the previously unrecognized pharmaceutical activity common to all compounds of the instant invention, viz., the treatment of diseases which cause an excess of metal in the human or animal body. Similarly, Groups I and III are not patentably distinct since the scope of the latter group is fully embraced by the scope of the former group. With regard to Groups II and III, Applicants disagree with the Examiner's statement that Applicants' own claims and specification are evidence that the products as claimed in Claims 5-10 can be each used in materially different processes. Applicants respectfully submit that the instant application only describes the use of said products in a common process, viz., the treatment of diseases which cause an excess of metal in the human or animal body.

In view of the foregoing, it is clear that Groups I, II and III are not patentably distinct and that the subject matter of Claims 1-11 (now Claims 1-14) is directed to one and the same invention.

In addition, the Examiner requires the election of a single disclosed species. In accordance therewith, Applicants respectfully elect the specific compound of Example 5, which is covered by Claim 9. Claims 1-11, 13 and 14 read on the elected species.

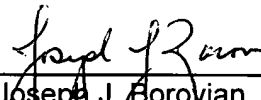
Assuming that the election of species requirement was made in accordance with 37 C.F.R. §1.146, Applicants' election of the compound of Example 5 is made without traverse. However, as set forth in M.P.E.P. 809.02(c), "[a]n examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species." If, however, the election of species requirement was not made pursuant to 37 C.F.R. §1.146, the aforementioned election is made with traverse on the grounds that there is no basis for the requirement in the statute or the rules.

In view of the foregoing, an action on the merits of all of the claims which read on the elected compound, viz., Claims 1-11, 13 and 14, is respectfully requested.

Although three claims have been added by this Amendment and Election, the total number of claims now present in the subject application does not exceed the highest number previously paid for. Accordingly, no additional fee is necessitated by the added claims. However, since this Amendment and Election will be deemed to have been filed more than one month from, but within two months of, the date of the Office Action, i.e., October 11, 2001, it is respectfully requested that the period for filing a response to said Office Action be extended by one month. Hence, charge the \$110 fee required by 37 C.F.R. §1.17(a)(1) for a one-month extension of time to Deposit Account No. 19-0134 in the name of Novartis Corporation. In this connection, an additional copy of this page is appended.

Respectfully submitted,

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